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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,401	06/11/2001	Preeti Lal	PF-0397-3 CON	4608

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INCYTE GENOMICS, INC.  
PATENT DEPARTMENT  
3160 Porter Drive  
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EXAMINER

NOLAN, PATRICK J

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/879,401

Applicant(s)  
Lal et al.

Examiner  
Patrick J. Nolan

Art Unit  
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 11-17, 27, 28, and 45-48 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-7, 9, 11-17, 27, 28, and 45-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**Part III DETAILED ACTION**

1. Claims 1-7, 9, 11-17, 27-28 and 45-48 are pending.

**Restriction/Election**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-2, 16-17, 45-46, drawn to a polypeptide, SEQ ID.. NO. 1 classified in class 530, subclass 350.

Group II. Claims 3-7, 9, 11, 47-48, drawn to a polynucleotide, encoding SEQ ID. NO. 1, classified in class 536, subclass 23.5.

Group III. Claims 12, drawn to a polynucleotide probe, derived from SEQ ID. NO. 2, classified in class 536, subclass 24.3.

Group IV. Claims 13-15, drawn to a method of detecting with a polynucleotide of SEQ ID. NO. 2, classified in class 435, subclass 6.

Group V. Claim 27; drawn to a method of screening with a polynucleotide of SEQ ID. NO. 2, classified in class 435, subclass 6.

Group VI. Claim 28, drawn to a method of screening with a probe derived from SEQ ID. NO. 2, classified in class 435 subclass 6.

Group VII. Claims 1-2, 16-17, 45-46, drawn to a polypeptide, SEQ ID. NO. 3 classified in class 530, subclass 350.

Group VIII. Claims 3-7, 9, 11, 47-48, drawn to a polynucleotide, encoding SEQ ID. NO. 3, classified in class 536, subclass 23.5.

Group IX. Claims 12, drawn to a polynucleotide probe, derived from SEQ ID. NO. 4, classified in class 536, subclass 24.3.

Group X. Claims 13-15, drawn to a method of detecting with a polynucleotide of SEQ ID. NO. 4, classified in class 435, subclass 6.

Group XI. Claim 27, drawn to a method of screening with a polynucleotide of SEQ ID. NO. 4, classified in class 435, subclass 6.

Group XII. Claim 28, drawn to a method of screening with a probe derived from SEQ ID. NO. 4, classified in class 435 sub 6.

The inventions are distinct, each from the other because of the following reasons:

3. Groups I, II and III are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct.

Groups IV-VI are unique methods. They differ with respect to ingredients and method steps and represent patentably distinct subject matter.

Groups II and IV or V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the polynucleotide can be used to make the protein.

Groups III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the probe can be used to make the peptide sequences for immunization protocols.

Groups VII, VIII and IX are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct.

Groups X-XII are unique methods. They differ with respect to ingredients and method steps and represent patentably distinct subject matter.

Groups VIII and X or XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the polynucleotide can be used to make the protein.

Groups IX and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

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product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the probe can be used to make the peptide sequences for immunization protocols.

Groups I-VI and VII-XII are unrelated products and methods and are therefore patentably distinct. The polypeptide of SEQ ID. NO. 1 potentially binds a totally different phospholipid, PC than SEQ ID. NO. 3 binds, PE, and there appears to be not substantial sequence homology between them, so a search for one polypeptide or polynucleotide would not substantially overlap with a search for the other.

4. Because a search of these twelve distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Tuesday through Friday from 9:00 am to 5:30 pm.

9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401.

*Pat J. Nolan*

Patrick J. Nolan, Ph.D.  
Primary Examiner, Group 1640  
June 2, 2003